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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,

Petitioner,

v.

HILTON-DAVIS CHEMICAL CO.,

Respondent.

On Writ of Certiorari to the United States
Court of Appeals for the Federal Circuit

**BRIEF OF AMICUS CURIAE
CHEMICAL MANUFACTURERS ASSOCIATION
IN SUPPORT OF RESPONDENT**

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**BRIEF OF *AMICUS CURIAE*
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STATEMENT OF INTEREST

The Chemical Manufacturers Association (CMA) is a non-profit trade association. Its members produce the vast majority of the basic industrial chemicals that are consumed in the United States. More than ninety percent of the U.S. chemical production capacity is owned by CMA member companies, who collectively manufacture more than 70,000 different chemical substances.

CMA members are prodigious users of the U.S. patent system. Thousands of U.S. patents are issued each year to CMA member companies. These patents are derived from the creative work of nearly 100,000 scientists, engineers and technicians employed in the industry's research and development laboratories.

Petitioner in this appeal has directly challenged the propriety and the legality, of construing patents to cover "insubstantial changes" beyond the patent's literal scope. CMA views the possible abolition of this fundamental principle of patent construction as a strike at the heart of the value of a patent in the chemical industry and the role of the patent as an effective incentive to develop new chemical technology. CMA has obtained the consent of both the Petitioner, Warner-Jenkinson, and the Respondent, Hilton-Davis, to file this amicus brief. Beyond opposing Petitioner's position on patent claim construction, CMA takes no position on the merits of the case.

SUMMARY OF THE ARGUMENT

After more than a century of interpreting patents as encompassing "equivalents" — insubstantial changes beyond a patent's literal scope — this Court has been asked by the Petitioner to limit the construction of a patent to a strict literal interpretation of the patent claims. The asserted attraction of such a strict literalism is its supposed precision, i.e., the public will supposedly have the benefit of enhanced certainty as to the effect of a patent.

Instead of enhancing certainty, limiting patents to a literal construction could produce a less certain, less uniform and more capricious patent construction. The doctrine of equivalents provides a principle of patent construction under

which the underlying *substance* of the patented invention must be fully and carefully assessed. Under a literal-only standard for patent construction, this principle would be gone. No doctrine or principle would then guarantee uniform treatment of substantively identical behaviors among accused infringers.

Two accused infringers, *practicing identical technology save for a mere colorable difference*, would — without a doctrine of equivalents — receive divergent treatment whenever one accused infringer falls within a patent's literal scope and the other is nestled just beyond the literal periphery. Today, under the doctrine of equivalents, the practice of a mere colorable change or an insubstantial difference over the literal patent construction does not provide a safe harbor against a charge of infringement — substantively identical behavior can be afforded uniform treatment.

Similarly, literal-only construction does not translate into greater certainty in construing a patent. The technical words and phrases used in a patent claim — especially in technology-intensive and arcane fields such as organic chemistry, materials science, biochemistry, and a host of medicinal chemical fields — are seldom understood in a facile and perfectly unambiguous manner. The result is that a court is often faced with multiple possible interpretations for a word used in the patent.

The uncertainties arising from possibly varying literal constructions are immediately diminished where the ultimate patent construction continues with a mandated focus on the substance of what is claimed. A court making an unusually technical interpretation of a word or a phrase in a claim, once refocused on the substantiality of the differences between the literally construed patent claims and the accused infringer's

conduct, can reach a conclusion equivalent to a less technical interpretation of the same word.

The doctrine of equivalents, because of this enhanced uniformity and certainty, assures inventors will have an enhanced possibility for adequate and effective protection for their inventions. The doctrine has an important remedial function in a variety of contexts. Where an ill-chosen word might otherwise be construed to produce a gap in literal protection, the doctrine of equivalents can operate to fill the technical void.

Finally, this Court has recently restated the policy objectives to be met in the process of construing a patent. The need to avoid the creation of a "zone of uncertainty" about a patent provides a cogent and compelling reason for maintaining, not excising, this doctrine from the construction of the patent. It is only with the doctrine of equivalents in force, not with its demise, that the adequate and effective protection of the invention can ever be married to certainty and predictability in claim interpretation.

ARGUMENT

I.

The Application of the Doctrine of Equivalents Advances, Rather Than Defeats, Uniformity and Certainty in the Construction of a Patent.

The construction of a patent focuses on the claims of the patent.¹ In the chemical arts, such claims can vary from a few words to a complex brew of words, structural formulas, analytical parameters, and other characterizing data. Not uncommonly in chemical technologies, patent claims will employ dozens and dozens of words in order to meet the statutorily required "definiteness"² in characterizing the invention.

¹ D. Chisum, *Patents* (1995), Glossary, describes the function of the patent claim:

An applicant for a patent must include in his application one or more claims which set forth the parameters of the invention. These claims measure the invention for determining patentability both during examination and after issuance when validity is challenged. They also determine what constitutes infringement. A claim recites a number of elements or limitations, and will cover or "read on" only those products (or processes) that contain all such elements or limitations.

² Section 112 of Title 35 sets forth the requirement that the claims of the patent describe the subject matter being claimed with definiteness. This requirement has been recognized as a relative, not an absolute requirement. *Charvat v. Commissioner of Patents*, 503 F.2d 138 (D.C. Cir. 1974), and *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124 (2d Cir. 1958), *cert. denied*, 358 U.S. 884 (1958).

D. Chisum, *Patents* (1995), §8.03 characterizes the statutory requirement in the following terms:

(...continued)

The many words in a patent claim — even when woven together in phrases and clauses that provide a *definite* identification of the subject matter of the patent — can be the subject of a spirited range of differing possible interpretations. Many patent litigations, including notable litigations involving sophisticated chemical compositions, have centered on the uncertainty over what literal scope for the claims will ultimately emerge from the litigation. The result has been prolonged uncertainty as to the literal meaning — up to and through the process of appellate review.³

The application of the doctrine of equivalents can work to diminish the “zone of uncertainty” inherent in any literal construction of a patent. By forcing the court to further consider the issue of “insubstantial differences,” the court is inherently forced to assess the underlying substance of the

² (... continued)

The standard of definiteness is one of *reasonableness under the circumstances*. It is whether, in the light of the teachings of the prior art and of the particular invention, the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. [Emphasis supplied.]

³ *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir., 1995), provides a recent example of the complexity — and inherent uncertainties — involved in the literal construction of a patent claim. At trial, both parties to the litigation advanced an interpretation of a claim alleged to infringe a patent. The trial court entered judgment against the defendant based on a finding of patent infringement tied to one of the two literal constructs. On appeal, the Federal Circuit construed the same claim in a different literal manner — a construction not argued by either party below. Based on this new literal construction, the Federal Circuit found no infringement and reversed the judgment in favor of the plaintiff-patentee.

invention. Often this has included consideration of whether the activity accused of infringement operates using substantially the same function in substantially the same way to produce substantially the same result. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950). This process of considering equivalents means that uncertainty based on multiple possible literal distinctions will diminish.

The same considerations operate to assure uniformity of result when the doctrine is invoked. Without a doctrine of equivalents, two accused infringers may be individually practicing substantively identical technology — save for a mere insubstantial or colorable difference between the two — but find themselves treated differently under a literal-only standard for patent construction. If only a *literal construction* is considered, one of the accused infringers may be found liable for literal infringement — being just inside the “metes and bounds” of the *literal* claims — while the second may just barely escape the patent’s literal reach.

Holding the second of two *substantially identically situated* accused infringers wholly free from the patent’s reach produces a manifest *non-uniformity*. With two accused infringers both practicing substantially the same subject matter, no sensible patent or public policy rationale supports such divergent results. The doctrine of equivalents can eliminate this non-uniformity — again by virtue of its unique requirement that a substantive evaluation of the accused infringing activity be undertaken.

Thus, without the doctrine of equivalents, patent construction can fall victim to a pernicious literalism. Since mere colorable differences — colorable changes in function, way, and result totally devoid of substance — will determine whether the accused infringer will or will not infringe, the

literal boundary of the claim becomes inordinately rigid. Where one arcane technical word used in the patent claim is given a slightly less generous literal construction by a court, a claim of infringement is entirely defeated. Because the doctrine of equivalents can self-correct the subtle and insubstantial variations that are possible in literal claim construction, it diminishes the non-uniformities and uncertainties inherent in construing a patent.

II.

The Doctrine of Equivalents Should be Preserved Because It Works Efficiently to Provide The Inventor With a Reasonable Scope of Patent Protection.

The doctrine of equivalents injects both reality and practicality into the process of construing a patent. It is a direct and effective means of assuring that a deserving inventor can be accorded a reasonable scope of protection. Simultaneously, it assures that the public can reasonably rely on the patent claims as the indicator of the scope of that protection.

The well-developed decisional law applying this doctrine dictates this result. For example, the courts have long limited the doctrine to prevent recapturing any subject matter that was known or obvious within the prior art. *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677 (Fed. Cir. 1990), *cert. denied*, 488 U.S. 992 (1990). Similar proscriptions eliminate from the reach of the doctrine subject matter voluntarily surrendered to the public during the course of patent procurement. *Charles Greiner & Co., Inc. v. Mari-Med Mfg., Inc.*, 962 F.2d 1031 (Fed. Cir. 1992). Most importantly, the courts can apply the doctrine — particularly in the chemical field — to carefully filter away any substantial (and, therefore, non-infringing) change from truly insubstantial differences.

The doctrine can be made to work effectively, much like other rules of interpretation applied to other types of documents. Statutes are not read with a surgical literalism that ignores the statute's ultimate effects. Contracts are not deliberately construed with a technical literalism that defeats the discernable intent of the parties. Patent claims have not, and should not, be similarly imprisoned by words without a full inquiry into their contextual meaning.

III.

Without the Ability to Rely on Equivalents, Patent Procurement — Particularly for Technically Complex Chemical Inventions — Would Become Burdensomely Complex.

For every judicial action, there can be anticipated an equal and opposing practitioner reaction. If this Court takes the extraordinary step of mandating patent construction without regard to equivalents, the focus of the inventor's patent procurement effort will lurch toward the use of additional words to describe the invention. Without some interpretative means to assure the construction of a patent would focus on its substance, the inventor would be forced into needless and wanton prolixity in claiming the invention. Synonymous words, duplicative words, cumulative words, and alternative words would suddenly become the prime currency of the patent document.

The object of patent procurement would center on the presentation of every conceivable verbal formulation of the "metes and bounds" of the underlying invention. The mission of the patent solicitor would be to inject into the patenting process every conceivable verbal formulation that might capture some otherwise literally uncaptured formulation of the substance of the invention.

No conceivable policy justification can exist for forcing inventors to draft such a plethora of claims solely in an attempt to capture colorable changes. The protection afforded to inventors should not depend on the verbal virtuosity of their patent solicitors to a greater extent than on the underlying technical merits of their respective contributions to the useful arts.

IV.

The Preservation of the Doctrine of Equivalents is Fully Consistent With the Court's Pronouncements in *Markman*.

The result being urged herein is wholly consistent with this Court's recently expressed views on patent construction expressed in *Markman v. Westview Instruments, Inc.*, 64 U.S.L.W. 4263 (U.S. April 23, 1996). The holding in *Markman* affirmed that the "construction of a patent is exclusively within the province of the court." Even though the court below indicated that the factual question of equivalents was a matter for the jury, the application of the doctrine clearly results in the "construction of a patent." However, the doctrine need not be abolished or restrained simply because *Markman* might be read to mandate that the application of the doctrine as a matter for the court, not the jury.

The *Markman* court expressly recognized that complex doctrines of claim interpretation exist — "the claims of patents have become highly technical in many respects *as a result of special doctrines* relating to the proper form and scope of claims that have been developed by the courts and the Patent Office" (emphasis supplied). Presumably, the doctrine of equivalents is one of these "special doctrines."

Moreover, the force of the argument that the court, not the jury, should interpret patent claims was ascribed in *Markman*

to a desire for "uniformity in the treatment of a given patent." The *Markman* court viewed such uniformity "as an independent reason to allocate all issues of construction to the court." It further quoted *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938), to the effect that "[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public," noting that otherwise a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field."

Setting the task of construing "insubstantial differences" under the doctrine of equivalents as a matter of law for the court merely recognizes this doctrine of claim interpretation. Moreover, if determining the "insubstantial differences" were undertaken by the court, this assignment would most certainly assure that same uniformity in the application of this doctrine that the *Markman* court describes as an essential policy objective for all doctrinal issues of patent construction. Finally, it would work to avoid the "zone of uncertainty" that might be supposed if the doctrine of equivalents were for some reason, uniquely among doctrines of patent construction, to be assigned to the jury.

Accordingly, this Court faces no impediment in reaching a decision under a *Markman*-driven rationale that the matter of "insubstantial differences," like other doctrinal issues in the province of patent construction, must be assigned to the court. To the contrary, such an affirmance would serve to strengthen the doctrine by further promoting the precision and uniformity of its application — in harmony and in unison with the other patent construction issues left for the court.

For the patent system to operate as a stimulus to innovation in the chemical industry, the objective of promoting precision and uniformity must be paramount. It sharpens the incentive to innovate, while it reduces the potential for needless and wasteful conflicts among innovators. With the escalating costs of patent litigation being a matter of no small concern to the chemical industry, a decision by this Court affirming the vitality of a doctrine of equivalents focused on "insubstantial changes" would have a salutary effect.

CONCLUSION

Petitioner seeks to use the definiteness requirement for patent claims as support for the proposition that the doctrine of equivalents must be eradicated from patent jurisprudence. It is, however, the presence of the doctrine of equivalents, not its abolition, that promotes the certainty and uniformity in infringement determinations which Petitioner argues the statute and its policy underpinnings demand. The doctrine, properly circumscribed, should be applied with other special doctrines of claim construction to construe a patent.

The Court has recently spoken in *Markman* that the various doctrines of patent construction, being matters for the court rather than the jury, will work to achieve a greater uniformity and to eliminate any "zone of uncertainty" surrounding patent construction. The doctrine of equivalents applied by the court

is fully consistent with this policy. Moreover, it could work to achieve the full vindication of the policy.

Respectfully submitted,

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